

OCT 04 2007

Application No. 10/629,063
Docket No. 200309257-1REMARKS

Applicant expresses appreciation to the Examiner for consideration of the subject patent application. This amendment is in response to the Office Action mailed July 5, 2007, in which claims 1, 4, 7, 8, 12, 14-16, 18, 20, 23, and 26-32 were rejected under 35 U.S.C. § 102(c) as being anticipated by U.S. Pub. No. 2003/0025321 A1 (hereinafter "Lee").

It is respectfully submitted that the presently pending claims be examined and allowed.

Claim Rejection under 35 U.S.C. § 102

The Examiner has rejected claims 1, 4, 7, 8, 12, 14-16, 18, 20, 23, and 26-32 under 35 U.S.C. § 102(c) as being anticipated by Lee. In discussing this rejection, Applicants deem it appropriate to reemphasize certain important requirements for sustaining such a rejection. First, "anticipation requires that each and every element of the claimed invention be disclosed in a prior art reference." *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1981), *cert denied*, 469 U.S. 851 (1984). In addition, "[t]he identical invention must be shown in as complete detail as is contained in the...claim." *Richardson v. Suzuki Motor Co.* 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989). Importantly, in disclosing the invention, the reference must disclose all the elements as arranged in the claim. *See Connell v. Sears, Roebuck, & Co.*, 722 F.2d 1542, 1547 (Fed. Cir. 1983).

Applicants submit that Lee does not disclose Applicants' invention according to the standards of U.S. patent law, because Lee fails to disclose the elements and arrangement thereof required by the present claims. The presently pending claims set forth a print medium having a data storage device in or on only a portion of the print medium. Lee, on the other hand, teaches a print medium that includes a magnetic layer that is the same size of the ink receptive layer. Therefore, the boundaries of the magnetic layer and of the ink receptive layer(s) are entirely coincident. See, e.g. Fig. 2. Such a device cannot be said to be "in or on only a portion of" the print medium without disregarding the conventional meaning of such a phrase. The Examiner has asserted that the magnetic layer of Lee is in or on only a portion of the print medium because "it does not exist throughout the entire structure of the print medium...and it does not lay on top of all of the layers of the print medium..." However, Applicants submit that a reasoned

Application No. 10/629,063
Docket No. 200309257-1

consideration of the Lee disclosure will show that such a description of the magnetic layer runs counter to accepted meaning of the words used. Further, such an interpretation does not appear to accept the plain meaning of the claim language at issue in the present application.

To be attached to the print medium, a device must either be inside it, or outside of it in some way while still attached. If the device is neither alongside the medium nor penetrating through it, then the only remaining alternative that qualifies as being both outside (i.e. not inside) and attached is for the device to be on the medium. Accordingly, these two possibilities (in or on) are recited in the alternative in the presently pending claims. Having established this, it is clear that the magnetic layer of Lee exists in the print medium disclosed therein. To be on any portion of the medium, the layer would have to be outside the medium, which it clearly is not. Therefore, the magnetic layer of Lee cannot anticipate a device of the present claims that is on the print medium.

It is also clear that the magnetic layer of Lee, which must be in the print medium, is in all of the print medium. As stated above, the layer's boundaries are coincident with that of the print medium. To accept the Examiner's assertion—that such a layer is in only a portion of the print medium because it does not exist throughout the entire structure thereof—would be to make the concept “in all of” an absurdity and to render the phrase “in only a portion of” meaningless. By the Examiner's definition, the only way for the magnetic layer to be in all of the print medium would be for the total volume (height x width x length) of the print medium to consist of the magnetic layer. In other words, the magnetic layer would be the whole print medium. Therefore, it follows from the Examiner's reasoning that to be “in only a portion of” a structure is meaningless, because for something to be “in all of” the structure would require the structure to be totally absent. Thus, the Applicants assert that according to conventional usage, the magnetic layer of Lee is in all of that print medium in the only logical sense of that phrase in reference to a sheet structure. It therefore follows that for a device to be in only a portion of such a print medium, its boundaries must encompass a smaller area than that of the print medium. Such an arrangement is recited in the present claims and is not anticipated by the magnetic layer in the disclosure of Lee.

The Examiner has also asserted that Lee's mention of a magnetic strip anticipates the present claims. The Examiner goes on to cite *Celeritas Technologies Ltd. v. Rockwell Int'l Corp.*

Application No. 10/629,063
Docket No. 200309257-1

in asserting that Lee's disparagement of a magnetic strip does not negate said anticipation. However, Applicants must again assert that Lee does not disclose Applicants' invention simply by mentioning a magnetic strip without any teaching of its relationship to any other elements of said invention. To do so, Lee would have had to disclose the elements of the claim as arranged in the claim. Applicants submit that the present case is distinguishable from *Celeritas* and the other cases cited in MPEP 2131.05 in that the prior art references in those cases each explicitly or inherently disclosed --and then taught away from--a claimed invention. Lee does not disclose the present invention by its isolated mention of a possible element which could be situated in any number of collocations of other elements that bear no resemblance to those claimed. As such, Lee does not anticipate the present invention under any section of 35 U.S.C. § 102. At most, this reference raises a question of obviousness under 35 U.S.C. § 103(a), but is not available as a prior art reference under that section. Applicants therefore respectfully submit that this rejection be withdrawn and the pending claims passed to issue.

OCT 04 2007

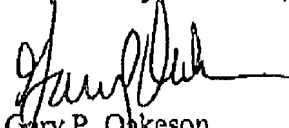
Application No. 10/629,063
Docket No. 200309257-1**CONCLUSION**

In light of the above, Applicant respectfully submits that the pending claims are now in condition for allowance. Therefore, Applicant requests that the rejections and objections be withdrawn, and that the claims be allowed and passed to issue. Further, all claims that had previously been withdrawn which related to the election of species requirement are believed to now be also allowable, as all independent claims are generic and are in allowable condition. Reconsideration of the election of species requirement is also requested. If any impediment to the allowance of these claims remains after entry of this Amendment, the Examiner is encouraged to call Gary Oakeson at (801) 566-6633 so that such matters may be resolved as expeditiously as possible.

The Commissioner is hereby authorized to charge any additional fee or to credit any overpayment in connection with this Amendment to Deposit Account No. 08-2025.

DATED this 4th day of October, 2007.

Respectfully submitted,



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